

REMARKS

The Examiner indicates that the new ground(s) of rejection were necessitated by "Applicant's Amendment Paper No. 14." See page 8 of the final Office Action. In the first Office Action, all claims were rejected under 35 U.S.C. §112, second paragraph for indefiniteness. Although claims 24 and 27 were rejected on prior art grounds, there was no prior art rejection made with respect to claims 1-23. In this third Office Action made final, the Examiner for the first time applies prior art to claims 1-23.

Although Applicants are unable to ascertain which paper in the Examiner's file corresponds to Paper No. 14, it is certainly the case that the response to the Restriction Requirement dated October 27, 2003 did not amend any of claims 1-23. The Response filed on in June 4, 2003 responded to the Examiner's request that the third line from the bottom of claims 1 and 12 be clarified. The clarifying amendment simply changed "amounts to" to "equals or exceeds." There was certainly no narrowing of the claim or adding further subject matter that required further consideration or search. All of the other changes to the claims relate to editorial type changes such as removing "characterized by" language and changing the verbs to gerunds in the various method steps. In addition, the underlined step "said customer account manager delivering a deposit to said mediating trusted agent" in claim 1 was simply text broken out from the earlier claim paragraph to make the claim easier to read. There are no prior amendments to claims 1-23 that justify making this first prior art rejection on the merits of claims 1-23 final.

MPEP §706.07(a) indicates that second or subsequent actions on the merits should not be made final "where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims, nor based on information submitted in Information Disclosure Statement...." This section of the MPEP also states that the second or subsequent action on the merits:

should not be made final if includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed...for example, one would reasonably expect that a rejection under 35 U.S.C. §112 for reason of incompleteness would be replied to by an amendment supplying the admitted element.


The citation of Rosen and Mao against claims 1-23 could have and should have been applied with respect to the originally-presented claims. The application of Rosen and Mao in the most recent Office Action, and the making of that action final, precludes a development of a clear issue between the Examiner and Applicant on the relevance of these references to the claimed invention. Applicants should not be limited by the restriction requirements of 37 CFR §1.116 in responding to the issues raised by the newly-applied art in the most recent Office Action.

It is therefore respectfully requested that the finality of the Office Action be withdrawn as premature. An early decision on this request is earnestly solicited so that Applicant knows whether a Notice of Appeal needs to be filed prior to the expiration of the statutory six month period.

Lars ANGELIN
Appl. No. 09/718,411
June 28, 2004

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
John R. Lastova
Reg. No. 33,149

JRL:at
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100